

### **Remarks**

Applicants wish to thank the Examiner for the careful consideration given this case. Claims 1, and 3-19 are pending in this application. Claims 1 and 4-6 have been amended. Claim 2 has been cancelled. Support for all amendments can be found in the Specification as originally filed. Now new matter has been added.

### **Finality of the Rejections**

Applicants submit that the finality of the Office Action mailed August 15, 2006 is premature and inappropriate. In particular, MPEP 706.07 (a) specifically states that an action shall not be made final where "the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement" and an action on the merits "should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations that should reasonably have been expected to be claimed". Both grounds of rejection in the current Office Action are "new" having not been recited in the first Office Action mailed January 25, 2006. Moreover, neither reference has been cited by the Applicants in the Information Disclosure Statement filed December 3, 2003 or by the Examiner in the Notice of References Cited supplied in the previous Office Action, and therefore, neither U.S. Patent No. 5,683,819 nor U.S. Patent No. 6,268,417 has been made of record. Furthermore, the amendments to claims provided in the Response and Amendment filed on May 25, 2006 did not include the addition of any new limitations to independent Claims 1 or 6, and should have been expected by the Examiner. Accordingly, the finality of the Office Action mailed August 15, 2006 should be withdrawn.

### **Rejection under 35 U.S.C. § 102**

Claims 1-2, 4-7, 10-13 and 15-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,683,819 to Mori et al. (hereinafter "Mori").

The Examiner alleges that Mori teaches a copolymer having a Mooney viscosity of 15 to 200 that exhibits good adhesion upon sulfur vulcanization (curing), and that this disclosure anticipates independent Claims 1 and 6. Applicants respectfully disagree.

It is well settled that in order for a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 USC § 102 presupposes knowledge of one skilled in the art of the claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. See Motorola Inc. v. Interdigital Technology Corp. 43 USPQ2d 1481 (1997 CAFC).

Mori fails to disclose each and every element of amended independent Claims 1 and 6 because Mori fails to teach or suggest a hydrogenated nitrile rubber having a Mooney viscosity of below 15 as recited in amended independent Claims 1 and 6. In particular, Mori teaches that the co-polymers of Mori should have "a Mooney viscosity of 15 to 200, preferably 30 to 100", and teaches against a Mooney viscosity "smaller than 15", as "satisfactory bonding strength cannot be obtained and the strength of vulcanized product is not high" (See column 2, lines 32-39). Accordingly, Mori fails to anticipate amended independent Claims 1 and 6.

Claims 3-5, 7, 10-13 and 15-17 either directly or indirectly depend from and add further limitations to amended independent Claims 1 and 6, and are respectfully deemed allowable at least for the same reasons in combination with amended independent Claims 1 and 6. Reconsideration and withdrawal of the Examiner's rejection is respectfully requested.

#### **Rejection under 35 U.S.C. § 103**

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,268,417 to Ozawa et al. (hereinafter "Ozawa") in view of Mori.

The Examiner alleges that it would have been obvious to prepare a rubber composition of a hydrogenated acrylonitrile/butadiene copolymer rubber polymer, a crosslinkable polymer, a crosslinking agent, and silica (and/or other fillers/additives) as described by Ozawa with a Mooney viscosity of the range described by Mori to prepare a tape having satisfactory bonding and high vulcanization strength. Applicants respectfully disagree.

First and foremost, neither Ozawa nor Mori teach or suggest an adhesive polymer composite of a hydrogenated nitrile rubber polymer having a Mooney viscosity of less than 15 as recited in amended independent Claims 1 and 6. Accordingly, this combination of references fails to teach or suggest all of the limitations of amended independent Claims 1 and 6.

Moreover, the Examiner concedes that Ozawa fails to limit the Mooney viscosity for the hydrogenated nitrile rubber polymer. Mori fails to cure this deficiency because Mori teaches against a co-polymer having a Mooney viscosity "smaller than 15" and requires the Mooney viscosity to be from 15 to 200 and preferably 30 to 100 (See above). Therefore, this combination of references fails to provide motivation to modify the disclosure of Ozawa by preparing an adhesive co-polymer having a Mooney viscosity of less than 15 as recited in amended independent Claims 1 and 6 because, based on the teachings of Mori, the resultant co-polymer would not have "satisfactory bonding strength".

Furthermore, Mori teaches that "prior to combination of the fibrous material with the nitrile group-containing highly saturated co-polymer rubber, the fibrous material is treated with an adhesive" (column 8, lines 50-52). Applicants clearly show the claimed adhesive polymer composite does not require an adhesive for binding to a substrate, and shows the criticality of the Mooney viscosity being below 15 in the Examples on pages 25-29. In particular, the uncured polymer of Example 1 of the present application having a Mooney viscosity of 1.5 shows vast improvement in stickiness to steel and adhesion to brass (See Table 3) over currently available polymers in the absence of an adhesive. These results would be completely unexpected in view of Ozawa in view of Mori, and the skilled artisan would have no expectation of successfully preparing an adhesive polymer composite by lowering the Mooney viscosity or removing the adhesive from the polymer composites of Ozawa in view of Mori.

Moreover, Applicants rebut the Examiner's presumption of obviousness. In particular, Mori teaches against the range recited in amended independent Claims 1 and 6, which provides clear evidence of unexpected results because the claimed co-polymers show excellent bonding strength and good durability. Accordingly, Applicants

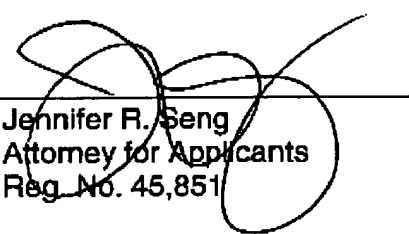
satisfy the requirements of MPEP 2144.05 III which states that "Applicants can rebut a presumption of obviousness based on a claimed invention that falls within a prior art range by showing '(1) [t]hat the prior art taught away from the claimed invention... or (2) that there are new and unexpected results relative to the prior art". *Iron Grip Barbell Co., Inc. v. Sports, Inc.*, 392 F.3d 1371, 1322 73 USPQ2d 1225, 1228 (Fed. Cir. 2004). Accordingly, Mori fails to render amended independent Claims 1 and 6 obvious.

Accordingly, Ozawa in view of Mori fails to render amended independent Claims 1 and 6 obvious. Claims 3-5 and 7-19 either directly or indirectly depend from and add further limitations to amended independent Claims 1 and 6, and are respectfully deemed allowable at least for the same reasons in combination with amended independent Claims 1 and 6. Reconsideration and withdrawal of the Examiner's rejection is respectfully requested.

It is respectfully submitted that the instant application, including Claims 1 and 3-19, is presently in condition for allowance. Notice to the effect is earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

By

  
Jennifer R. Seng  
Attorney for Applicants  
Reg. No. 45,851

December 14, 2006

LANXESS Corporation  
Law & Intellectual Property Department  
111 RIDC Park West Drive  
Pittsburgh, Pennsylvania 15275-1112  
(412) 809-2233  
FACSIMILE PHONE NUMBER:  
(412) 809-1054

\\sr\S\Law Shared\SHARED\NK\PATENTS\8040\Response and Amendment 12-14-06.DOC

PO-8040

8